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17 UNITED STATES DISTRICT COURT  
18 CENTRAL DISTRICT OF CALIFORNIA

19 JIPC MANAGEMENT, INC.,

20 Plaintiff,

21 v.

22  
23 INCREDIBLE PIZZA CO., INC.;  
24 INCREDIBLE PIZZA FRANCHISE  
GROUP, LLC; CJM RACING, LLC.,

25 Defendant.

Case No. CV08-4310 MMM (PLAx)

**PLAINTIFF'S OPPOSITION TO  
DEFENDANTS' MOTION IN  
LIMINE NO. 11 RE: EVIDENCE  
OF ALLEGED ACTUAL  
CONFUSION**

**Hon. Margaret M. Morrow**

**Date: July 13, 2009**

**Time: 9:00 a.m.**

**Ctrm: Roybal 780**

1 Plaintiff JIPC Management, Inc. (“JIPC”) submits this Opposition to  
2 Defendants’ Motion in Limine No. 11 Re: Actual Confusion After Adoption of a  
3 Similar Tagline (“MIL No. 11”).

## 4 **MEMORANDUM OF POINTS AND AUTHORITIES**

### 5 **I. Introduction.**

6 Defendants’ MIL No. 11 is one of several misguided attempts by Defendants  
7 to exclude evidence of actual confusion. Defendants’ MIL No. 11 seeks to preclude  
8 any evidence of any actual confusion that arose after JIPC adopted the tagline “All  
9 You Can Eat Food & Fun” because, according to Defendants, such tagline is  
10 “strikingly similar” to a tagline allegedly adopted by Defendants in 1999, “Great  
11 Food, Fun, Family & Friends.” For several reasons, Defendants’ MIL No. 11 is  
12 meritless and should be denied.

### 13 **II. The Court Must Consider Evidence of Actual Confusion.**

14 Evidence of actual confusion is one of the factors a court must consider in  
15 determining whether there is a likelihood of confusion. *AMF Incorporated v.*  
16 *Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979). Indeed, the *Sleekcraft* Court  
17 noted that “[e]vidence that use of the two marks has already lead to confusion is  
18 persuasive proof that future confusion is likely.” *Id.* at 352 (*citing Plough v. Kreis*  
19 *Laboratories*, 314 F.2d 635, 639 (9th Cir. 1963)). As McCarthy has noted:

20 Actual confusion is the best evidence of a likelihood of  
21 confusion. Convincing evidence of significant actual  
22 confusion occurring under actual marketplace conditions  
23 is the evidence [sic] of a likelihood of confusion. Any  
24 evidence of actual confusion is strong proof of the fact of  
25 a likelihood of confusion. No matter how convinced a  
26 trial judge may be of the absence of any likelihood of  
27  
28

1                   confusion, he or she must at least listen to evidence  
2                   presented of actual confusion.

3                   4 *McCarthy on Trademarks and Unfair Competition*, Section 23:13, pgs.  
4                   23-88 to 23-89 (2009)(citations omitted).

5                   Because evidence of actual confusion is significant and potent evidence of a  
6                   likelihood of confusion, it is not surprising that Defendants seek to preclude such  
7                   evidence. But Defendants’ MIL No. 11 is misguided, and not supported by the  
8                   cases cited by Defendants or otherwise.

9                   **III. Defendants’ Attempt to Exclude Evidence of Actual Confusion Puts the**  
10                   **Cart Before the Horse.**

11                   Defendants’ attempt to argue that use of the two taglines may have  
12                   contributed to actual confusion is a “red herring” and is not supported by any  
13                   evidence. Among other things, on their face, the two taglines are simply not  
14                   similar. Moreover, Defendants ignore that both JIPC and Defendants usually use  
15                   their marks without the taglines. (Klein Dec., Exs. 1 [JIPC examples], 2 [IPC  
16                   examples].) In short, Defendants will be unable to establish that the taglines are  
17                   relevant to the issue of confusion or any other issue. But even setting that aside,  
18                   Defendants’ MIL No. 11 puts the cart before the horse.

19                   To the extent Defendants wish to argue at trial that the taglines are somehow  
20                   relevant, they may do so, but there is absolutely no authority for the relief  
21                   Defendants seek, *i.e.*, a pretrial Order excluding all evidence of actual confusion.  
22                   Essentially, by Defendants’ MIL No. 11, they are seeking partial summary  
23                   judgment that use of the tagline prevents JIPC from establishing likelihood of  
24                   confusion.

25                   The **only** case cited by Defendants, *Kendall-Jackson Winery, Ltd. v. ENJ*  
26                   *Winery*, 150 F.3d 1042 (9th Cir. 1998) does not support Defendants’ position. In  
27                   that case, the Ninth Circuit merely affirmed a District Court’s finding that the  
28                   plaintiff was not entitled to equitable relief under state law claims because shortly

1 prior to the trial, the plaintiff had changed its mark to closely resemble the  
2 defendant's mark. *Id.* at 1052-53. The plaintiff's trademark infringement claim  
3 was decided on other grounds and the Court did **not** preclude evidence of actual  
4 confusion occurring after plaintiff's adoption of the similar mark. Thus, even if the  
5 *Kendall-Jackson* case were similar factually to this case (which it is not), it does not  
6 support Defendants' attempt to preclude introduction of evidence of actual  
7 confusion.

8 Moreover, both the *Kendall-Jackson* case and the portion of McCarthy cited  
9 by Defendants apply only to "equitable relief." At most, therefore, these authorities  
10 stand for the proposition that, under appropriate facts, a plaintiff may not be able to  
11 obtain equitable relief if the plaintiff takes steps to move its own mark closer to  
12 defendant's mark. They do not stand for the proposition that a court should exclude  
13 all evidence of actual confusion.

14 Even if Defendants had a legitimate claim that JIPC has sought to move its  
15 mark closer to Defendants' mark (they do not), the Court can consider Defendants'  
16 argument at trial. But there is no authority for the Court to exclude all evidence of  
17 actual confusion.

#### 18 **IV. Conclusion.**

19 In light of the foregoing, the Court should deny Defendants' MIL No. 11.

20 DATED: June 29, 2009

STOEL RIVES LLP

21 By: /s/Steven E. Klein

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